

Appl. No. 09/997,513
Amtd. Dated May 9, 2005
Reply to Office Action of March 16, 2005

Docket No. IRI05441
Customer No. 23330

REMARKS

Claims 1-24 remain in the application. The actions taken are in the interest of expediting prosecution and with no intention of surrendering any range of equivalents to which Applicants would otherwise be entitled in view of the prior art. Moreover, the amendment or cancellation of claims herein is without prejudice to pursuing claims of different scope by way of continuing Application. Reconsideration of this application is respectfully requested.

35 U.S.C. § 103

The Office Action states that claims 1-4, 6, 8-18, and 20-23 are rejected under 35 U.S.C. § 103 for allegedly being unpatentable over U.S. Patent No. 6,108,540 issued to Sonti et al. ("Sonti") in view of U.S. Patent No. 6,453,162 issued to Gentry ("Gentry") in further view of Niepel et al. ("Niepel") (U.S. Patent No. 6,671,523).

The Office Action alleges that Sonti teaches the elements of independent claim 1, except for a personal HLR not located with the telecommunication service provider and a link to an OSS of the telecommunication service provider for obtaining services. Additionally, the Office Action alleges that Sonti teaches the elements of independent claim 13, except for a processor means including the HLR, said processor means operating independent of the telecommunications service provider and said processor means coupled to said telecommunications service provider for communication and the elements of independent claim 21, except for an HLR processor within a particular user and said service provider coupled to said processor means, said network HLR pointing to said personal HLR. The Office Action further alleges that Gentry teaches access to an HLR via the Internet. The Office Action still further alleges that Niepel teaches the aforementioned deficiencies of Sonti and Gentry, specifically equating a SIM card in a mobile phone to an HLR. The Applicants respectfully disagree.

Sonti teaches a method for allowing subscribers of a telecommunications network to change easily between sets of desired features where a user dials a special code to change a profile containing different set of features for different users of the mobile station or for different times of day or geographic areas. Gentry teaches a method and system for provisioning a

Appl. No. 09/997,513
Amdt. Dated May 9, 2005
Reply to Office Action of March 16, 2005

Docket No. IRI05441
Customer No.. 23330

wireless component over an internet protocol network where a request to modify information in a location register is received from an input device coupled to an internet protocol network, the request is converted into an HLR access message, the HLR access message is sent to the location register, and information is modified in the location register in response to the HLR access message. However, nowhere do Sonti or Gentry disclose a personal home locator register located in a processor of a user, as recited in independent claim 1 and independent claim 21. Additionally, nowhere is there any mention of a processor means including the home location register, said processor means operating independent of the telecommunication service provider and located with a particular subscriber, as recited in independent claim 13. In fact, the Office Action alleges that Sonti teaches a user having access to an HLR function (which contains a processor), but admits that Sonti *"does not limit the scope/design of the patent by dictating where certain hardware is located and/or how it must be connected."* However, *Figures 1, 5, 6 and 7 of Sonti clearly teach that HLR (74) is located separately from users, who are at mobile stations (30).* Moreover, Gentry does not mention any processor, let alone a personal home located register located in a processor of a user. In fact, Figure 2 of Gentry clearly teaches and illustrates that HLR is NOT located in a processor of a user, since the user is at personal computer (48) and HLR (17) is located separately from personal computer (48) across the Internet (46).

The Examiner attempts to remedy the deficiencies of Sonti and Gentry by equating a SIM card in a mobile device to an HLR located in a network in Niepel. It is respectfully pointed out that this allegation is untenable. Niepel teaches a SIM card having a subscriber identity number. The identity number is linked to a subscriber profile in the subscriber register (e.g. a home location register (HLR)) (column 1 lines 7-17). *The subscriber profiles are suitably available and can be administered in the network* (column 2 lines 1-9). The Examiner alleges that Figure 2 of Niepel shows a SIM card storing a user profile and attempts to equate this to an HLR. However, a careful reading of Niepel unquestionable shows that the table of Figure 2 of Niepel merely shows the association of a SIM having a subscriber identity number to a user profile, where the table is at the HLR, not in the SIM (column 5 lines 42-53). Furthermore, it is clear in Figure 1 of Niepel that the HLR is not located with the mobile device (KE) (column 4 lines 25-49). So it is clear that Niepel teaches an HLR separate from the mobile device and does not

Appl. No. 09/997,513
Amdt. Dated May 9, 2005
Reply to Office Action of March 18, 2005

Docket No. IRI05441
Customer No. 23330

teach storing of subscriber profiles in a SIM card, but merely associating a subscriber identity to a subscriber profile at an HLR in a network.

So it is clear that Sonti, Gentry and Niepel teach HLR as being remote from a user. Therefore, Sonti, Gentry and Niepel teach away from Applicants claims. Teaching away is an important indicium of nonobviousness. U.S. v. Adams, 383 U.S. 39, 148 USPQ 479 (1966). Teaching away is the antithesis of the art suggesting that the person of ordinary skill go in the claimed direction. In re Fine, 5 USPQ2d 1596, 1599 (Fed. Cir. 1988).

Examiner alleges that by Sonti and Gentry not disclosing or limiting where hardware is located, that the personal HLR/database could be located either remotely or with the user. Applicants respectfully disagree. As shown above, both Sonti and Gentry teach that HLR is located separately from a user. Moreover, Applicants DO claim a limitation on the location of HLR - that HLR is located in the processor of a particular subscriber or user (independent claims 1, 13 and 21). It is clear that Niepel does not make up for the deficiencies of Sonti and Gentry, but reinforces those teachings. Even if Sonti and Gentry did not limit the location of the HLR (which Applicants believe they do), it is respectfully pointed out that the Examiner cannot read this limitation into Sonti and Gentry.

The rejection in question can only be based upon a hindsight reconstruction enlightened by Applicants' own disclosure. In other words, even if, as alleged by the Examiner, Sonti, Gentry and Niepel do not teach a particular location of HLR, it is improper hindsight for the Examiner to read the limitations on the location of HLR, as claimed by Applicants, into the teachings of Sonti, Gentry and Niepel.

The Examiner is well aware that the three necessary criteria for establishing a prima facie case of obviousness include 1) some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine reference teachings, 2) a reasonable expectation of success, and 3) the prior art reference or references must teach or suggest all the claim limitations. Accordingly, as Sonti, Gentry and Niepel fail to disclose, either explicitly or inherently, at least the above-noted elements of claims 1, 13, and 21 and the Examiner has failed to provide such an explicit or inherent disclosure of this element, it is respectfully submitted that the rejection of these claims

Appl. No. 09/997,513
Amdt. Dated May 9, 2005
Reply to Office Action of March 16, 2005

Docket No. IR105441
Customer No. 23330

and the claims that depend therefrom is improper and the Applicants request withdrawal of the § 103 rejection.

The Office Action states that claims 5 and 19 are rejected under 35 U.S.C. § 103 for allegedly being unpatentable over Sonti and Gentry/ Niepel and in further view of U.S. Patent No. 6,058,301 to Daniels ("Daniels").

Claim 5 depends from claim 1 and claim 19 depends from claim 13. Accordingly, these claims rely on the arguments presented above. Additionally, Daniels does not make up for the deficiencies of Sonti, Gentry and Niepel. Namely, nowhere does Daniels disclose a personal home locator register located in a processor of a user, as recited in newly amended claim 1. Additionally, nowhere is there any mention of a processor means including the home location register, said processor means operating independent of the telecommunication service provider and located with a particular subscriber, as recited in claim 13. Thus, it is respectfully submitted that the rejection of claims 5 and 19 is improper and the Applicants request withdrawal of the § 103 rejection.

The Office Action states that claim 7 is rejected under 35 U.S.C. § 103 for allegedly being unpatentable over Sonti and Gentry/Niepel and in further view of U.S. Patent No. 6,681,232 to Sistanizadeh ("Sistanizadeh").

Claim 7 depends from claim 1 and relies on the arguments presented above. Additionally, Sistanizadeh does not make up for the deficiencies of Sonti, Gentry and Niepel. Namely, nowhere does Sistanizadeh disclose a personal home locator register located in a processor of a user, as recited in newly amended claim 1. Thus, it is respectfully submitted that the rejection of claim 7 is improper and the Applicants request withdrawal of the § 103 rejection.

Allowable Subject Matter

Claim 24 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including of the limitations of the base claim and any intervening claims.

Prior Art

Appl. No. 09/997,513
Amdt. Dated May 9, 2005
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Docket No. IRI05441
Customer No.. 23330

The references cited but not relied upon are believed not to anticipate or make obvious Applicants' invention.

Summary

No amendment made was related to the statutory requirements of patentability unless expressly stated herein. No amendment made was for the purpose of narrowing the scope of any claim, unless Applicant has argued herein that such amendment was made to distinguish over a particular reference or combination of references.

The Applicants believe that the subject application, as amended, is in condition for allowance. Such action is earnestly solicited by the Applicants.

In the event that the Examiner deems the present application non-allowable, it is requested that the Examiner telephone the Applicant's attorney or agent at the number indicated below so that the prosecution of the present case may be advanced by the clarification of any continuing rejection.

Accordingly, this application is believed to be in proper form for allowance and an early notice of allowance is respectfully requested.

Please charge any fees associated herewith, including extension of time fees, to 502117, Motorola, Inc.

Respectfully submitted,

SEND CORRESPONDENCE TO:

Motorola, Inc.
1303 East Algonquin Road
IL01/3rd Floor
Schaumburg, IL 60196
Customer Number: 23330

By: 

Kevin D. Wills
Attorney of Record
Reg. No.: 43,993

Telephone: 602-952-4399
Fax No.: 602-952-4376